



ATTACHMENT A Remarks

Claims 1, 3-12, and 14-16 remain pending in the application. As discussed below, claims 1, 3, 5-12, and 14-16 have been amended for various purposes, including purposes of clarity and form, to correct antecedent basis problems, to address issues raised by the Examiner and to correct a typographical error. Claims 2 and 13 have been cancelled.

Considering the matters raised in the Office Action in the same order as raised, and turning first to the rejection of claims 14-16, these claims have been rejected under 35 U.S.C. § 101 because "the claimed invention is directed to non-statutory subject matter." This rejection is respectfully traversed, although claims 14-16 have been amended as discussed below.

In the rejection of claims 14-16, the Examiner has stated that a "[c]omputer readable medium is defined as pertaining to carrier waves on page 3, lines 13-14 of the specification. Carrier waves are non-statutory subject matter." Claim 14 has been amended, along with the claims 15 and 16 dependent thereon, and is now directed to a tangible computer-readable medium. Thus, claims 14-16 now exclude "carrier waves" and are in a format that has specifically been approved of by the courts.

Claims 1, 4, 8, 14, and 16 have been rejected under 35 U.S.C. § 102(e) as being "anticipated by" Burks. This rejection is respectfully traversed, although the claims have been amended to more clearly define over Burks.

First, while, as discussed below, the claims now presented are believed to be clearly patentable over Burks, the Burks publication was filed less than three weeks before the instant application and applicant reserves the right to swear behind Burks under Rule 1.131.

In rejecting claims 1, 4, 8, 14, and 16, the Examiner contends that Burks teaches "receiving a request for a new disk drive for an identified customer computer system (paragraph 21, lines 13-16; Note: if a replacement drive is being prepared, it is understood that there has been a request for one); retrieving an extended parts list for the customer computer system (paragraph 21, lines 16-19; lines 27-31; Note: the replacement drive contains information to allow the computer to locally download the

needed files which represents the extended parts list); [and] providing a restore program on the new disk drive (paragraph 21, lines 16-19; Note: if the restoration is done by locally downloading, there must be a program used to implement this procedure).”

Considering the cited lines from paragraph 21 of Burks, lines 13-18 state that “[s]ince many subscribers may rely on a single instance of a file for restoration purposes, storage requirements on backup/restoration server 116 are minimized. Further, since multiple subscribers may rely on the centrally archived backup copy of the files, each subscriber need not independently supply a copy of previously stored files. Even where subscriber files may slightly differ, known data compression techniques may be used to minimize the amount of storage required on backup/restoration server 116 to store information sufficient to reproduce the slightly differing files.” Thus, to summarize, the referenced lines merely disclose the benefits of using a central backup file repository to store a single copy of a particular file that users, with permission and rights to the file, may access it for backup purposes and to minimize storage needs.

Although it is respectfully submitted that the claims as originally presented patentably define over Burks, the claims have been amended to even more clearly define over that reference. In this regard, claim 1 has been amended to recite a “self-executing” restore program and that “upon installation of the new, self-executing restoration disk drive, the self-executing restore program restores the computer system to the original factory condition.” Burks does not teach or suggest a self-executing restore program much less such a program that automatically restores the computer system to original factory condition. Thus, it is respectfully submitted that claim 1 patentably defines for at least these reasons.

Claims 8 and 14 have been amended similarly to claim 1 and are allowable, as amended, for similar reasons.

Regarding the dependent claims, it is respectfully submitted that the dependent claims are allowable for at least the reasons set forth above in support of the patentability of the claims parent thereto.

Claims 2, 3, 6, 7, 9-13, and 15 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Burks in view of U.S. Publication No. 2002/0083367 to McBride (“McBride”). This rejection is respectfully traversed.

In the rejections of claims 6 and 9, the Office Action states that “Burks is relied upon for reasons stated in the previous section.” In rejecting claim 6, the Examiner cites paragraph 21 of Burks as teaching the fulfillment processor and the replacement hard drive creator of claim 6. Claim 6 has been amended similarly to claim 1 to recite a “self-executing restore program” and, in particular, to recite “retrieving a self-executing restore program that will, when executed, restore the computer system to original factory condition.” It is respectfully submitted that these recitations clearly define over Burks.

The Office Action states that McBride discloses an element not found in Burks, viz., a new disk drive in factory condition, and that one of reasonable skill in the art would have combined the references. MPEP 706.02(j) requires a suggestion, teaching, or motivation to combine references, and further requires that the combination must teach every element of the claim. It is respectfully submitted that the cited paragraph of McBride merely discloses restoring the system from the existing, sealed hard drive of the computer, not a replacement one. McBride, therefore, teaches away from the claimed invention, which is directed to a replacement disk drive. Moreover, it is respectfully submitted that, even assuming arguendo that combining the two references is proper, no fair combination of Burks and McBride would teach the elements of claim 6 discussed above. Thus, it is respectfully submitted that claim 6, as amended, is allowable.

In the rejection of claim 9, the Office Action states that Burks, in paragraph 21, teaches each element of claim 9 except for the element of “rebooting into the newly restored operating system.” The Office Action then states that the rebooting step is taught by McBride.

It is respectfully submitted that paragraph 21 of Burks does not teach the steps of “installing a factory-provided replacement hard disk; powering up the system; automatically executing a restore script” or “automatically using an extended parts list on the replacement hard disk drive . . .” as recited in amended claim 9. Further, although the Office Action states that the “rebooting into the newly restored operating system step” of claim 9 is disclosed by McBride, McBride is concerned with rebooting not from a replacement disk as claimed, but from a disk already installed and sealed in

the computer. Further, neither Burks nor McBride teaches accomplishing these steps automatically as recited in claim 9 as amended. Therefore, it is respectfully submitted, that claim 9, as amended, is now in condition for allowance.

Claim 5 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Burks in view of U.S. Patent No. 6,081,789 to Purcell ("Purcell"). Claim 5 is allowable for at least the same reasons that were set forth above with respect to the patentability of parent claim 1.

For the foregoing reasons, allowance of the application in its amended form is respectfully solicited.

END OF REMARKS